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PATENT APPLICATION
ATTORNEY DOCKET NO. 10992503-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Masumi Senoo et al.

Confirmation No.: 7752

Application No.: 09/506,418

Examiner: BRINICH, Stephen M

Filing Date: 02/17/2000

Group Art Unit: 2624

Title: Distributed Rendering of Print Jobs

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TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on 4/11/2005.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) $500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

( ) (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

- ( ) one month
- ( ) two months
- ( ) three months
- ( ) four months

( ) The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account **08-2025** the sum of $500.00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Number of pages: 17

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Respectfully submitted,

By Steven R. Sponseller

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No. 09/506,418
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Inventor.....Masumi Senoo et al.
Group Art Unit 2624
Examiner .....Brinich, Stephen M.
Attorney's Docket No. 10992503-1
Confirmation No. 7752
Title: Distributed Rendering of Print Jobs

APPEAL BRIEF

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Pursuant to 37 C.F.R. § 1.192, Applicant hereby submits an appeal brief for application 09/506,418, filed February 17, 2000, within the requisite time from the date of filing the Notice of Appeal. Accordingly, Applicant appeals to the Board of Patent Appeals and Interferences seeking review of the Examiner's rejections.

(1) Real Party in Interest

The real party in interest is Hewlett-Packard Development Company, a Texas Limited Partnership, having its principal place of business in Houston, Texas (an assignment to the Hewlett-Packard Development Company, L.P. was recorded on September 30, 2003, reel/frame 014061/0492), the assignee of all right, title and interest in and to the subject invention.

(2) Related Appeals and Interferences

Appellant is not aware of any other appeals, interferences, or judicial proceedings which will directly affect, be directly affected by, or otherwise have a bearing on the Board's decision to this pending appeal.

(3) Status of Claims

Claims 1-12 and 14-18 stand rejected and are pending in this Application. Claims 1-12 and 14-18 are appealed. Some of claims 1-12 and 14-18 were previously amended. Claims 13 and 19-24 were previously canceled. Claims 1-12 and 14-18 are set forth in the Appendix of Appealed Claims on page 12.

(4) Status of Amendments

A Final Office Action was issued on January 10, 2005.

Appellant filed a Notice of Appeal on April 11, 2005 in response to the Final Office Action.

No amendments have been filed subsequent to the Final Office Action of January 10, 2005.

(5) Summary of Claimed Subject Matter

A concise explanation of each of the independent claims is included in this Summary section, including specific reference characters. These specific reference characters are examples of particular elements of the drawings for certain embodiments of the claimed invention, and the claims are not limited to solely the elements corresponding to these reference characters.

With respect to independent claim 1, as discussed for example at page 7, line 17 through page 9, line 4 (and shown for example in Fig. 4), a method of handling a print job includes determining whether the entire print job can be processed by a printer (202). If the entire print job can be processed by the printer (204), the printer processes the print job (206). If the entire print job cannot be processed by the printer (204), the printer sends the print job to an external rendering device (212), receives a rendered print job from the external rendering device (214), and prints the rendered print job received from the external rendering device (216).

With respect to independent claim 8, as discussed for example at page 7, line 17 through page 9, line 4 (and shown for example in Fig. 4), a method includes a printer receiving a print job and identifying portions of the print job that can be processed by the printer (208). The printer processes the identified portions of the print job (210) and sends the portions of the print job that cannot be processed by the printer to an external rendering device (212). The printer then receives rendered portions of the print job from the external rendering device (214).

With respect to independent claim 15, as discussed for example at page 5, line 10 through page 7, line 5 and at page 7, line 17 through page 9, line 4 (and shown for example in Figs. 2 and 4), a printer (110) includes a

communication interface (128, 130) and a processor (120) coupled to the communication interface. The processor (120) determines whether an entire print job can be processed by the printer (204). If the entire print job cannot be processed by the printer, then the printer (120) sends the portions of the print job that cannot be processed by the printer to an external rendering device (212), and the printer receives rendered portions of the print job from the external rendering device (214).

(6) Grounds of Rejection to be Reviewed on Appeal

Claims 1-12 and 14-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,003,069 to Barry Richard Cavill (hereinafter "Cavill") in view of Appellant's admitted Prior Art.

(7) Argument

A. Rejection under 35 U.S.C. § 103(a) over U.S. Patent No. 6,003,069 to Cavill in view of Appellant's admitted Prior Art.

Claims 1-12 and 14-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cavill in view of Appellant's admitted Prior Art.

Cavill discloses:

> ... a new printer driver system which is surprisingly effective for use with NCs. In its simplest terms, the present invention divides the print task up into portions that can be processed locally and portions that can be processed by a server. Typically, the server will be more capable of processing data than the NC and will have a greater amount of storage space. The benefits of the invention are that the server is used for temporary storage and processing, thereby alleviating the burden on the

> NC. Printing of more complex, high quality information is more feasible than using the traditional driver inside the NC. (Col. 2, lines 37-47).

In discussing the printer driver system, the Cavill reference further states, "In essence, the driver is split between the NC and the server, with each part performing the tasks that are best suited for the systems on which they reside." (Col. 2, lines 56-59). The printer driver system disclosed in Cavill includes a client-side driver subsystem and a server-side driver subsystem. These two subsystems share print tasks. (See col. 3, line 58 – col. 4, line 10). The client-side driver subsystem is associated with the NC (network computer) and the server-side driver subsystem is associated with the server. After these two subsystems have processed a print job, the print data is sent to a printer device. (See col. 6, lines 24-28).

Claim 1 of the present application recites:

> A method of handling a print job, the method comprising:
> determining whether the entire print job can be processed by a printer;
> processing the print job, by the printer, if the entire print job can be processed by the printer;
> if the entire print job cannot be processed by the printer:
> sending, by the printer, the print job to an external rendering device;
> receiving, by the printer, a rendered print job from the external rendering device; and
> the printer printing the rendered print job received from the external rendering device.

Thus, claim 1 includes "if the entire print job cannot be processed by the printer: sending, by the printer, the print job to an external rendering device...." This feature is not disclosed or suggested by the Cavill reference. As discussed above, Cavill discloses a printer driver having a server-side subsystem and a client-side subsystem. These two subsystems are not part of

the printer device. In the disclosure of Cavill, the printer device is not involved in the separation of print tasks into multiple portions. Instead, the NC and the server handle one or more portions of a print task. After the NC and the server have handled their portions of the print task, the resulting print data is sent to a printer device. Therefore, Cavill does not disclose or suggest the printer sending the print job to an external rendering device. To the contrary, Cavill teaches processing the print data before the print data is send to the printer.

In rejecting claim 1, the Office Action also cites page 1, line 23 – page 2, line 6 of the present application (Appellant's admitted Prior Art). The cited language states:

> Other printers may be capable of processing print jobs in multiple languages. These printers are typically more complicated because they are required to identify, interpret and process print commands in several different languages. Although these printers are more complicated, they typically require an attached processing device to provide the print job and other printer control information to the printer. Another type of printer contains its own print rendering engine that is capable of generating a printed output document from raw print job data. Although this type of printer contains its own print rendering engine, it is typically coupled to a processing device, such as a computer, to receive the raw print job data generated, for example, by an application running on the computer.

The above discussion mentions that a printer may contain its own print rendering engine to process certain types of data. However, this discussion does not disclose or suggest the elements of claim 1. For example, the above discussion does not disclose or suggest "determining whether the entire print job can be processed by a printer" as recited in claim 1. Further, the above discussion does not disclose or suggest "if the entire print job cannot be processed by the printer: sending, by the printer, the print job to an external rendering device...." as recited in claim 1. Merely mentioning that a printer

may contain its own print rendering engine fails to disclose or suggest the claim limitations discussed above.

Further, the combination of Cavill and Appellant's admitted Prior Art fails to disclose or suggest a printer that sends a print job to an external rendering device if the entire print job cannot be processed by the printer, as recited in claim 1. Neither Cavill nor Appellant's admitted Prior Art discuss that a printer may determine whether an entire print job can be processed. Since neither reference individually discloses or suggests such a feature, the combination of Cavill and Appellant's admitted Prior Art fails to disclose or suggest this feature. Additionally, the combination of Cavill and Appellant's admitted Prior Art fails to disclose or suggest a printer that sends a print job to an external rendering device. Since neither reference mentions this functionality, the combination of references is silent regarding this claimed feature.

As such, Appellant respectfully submits that claim 1 is allowable over Cavill in view of Appellant's admitted Prior Art. Given that claims 2-7 depend from claim 1, Appellant respectfully submits that those claims are likewise allowable over Cavill and Appellant's admitted Prior Art for at least the reasons discussed above.

Claim 8 of the present application recites:

> A method comprising:
> receiving, by a printer, a print job;
> the printer identifying portions of the print job that can be processed by the printer;
> the printer processing the identified portions of the print job;
> the printer sending the portions of the print job that cannot be processed by the printer to an external rendering device; and
> the printer receiving rendered portions of the print job from the external rendering device.

As discussed above, the Cavill reference discloses a printer device that is not involved in the separation of print tasks into multiple portions. Instead, the separation of print tasks into multiple portions is performed by a printer driver having a server-side subsystem and a client-side subsystem. Thus, Cavill does not disclose or suggest "the printer identifying portions of the print job that can be processed by the printer", as recited in claim 8. Further, Cavill fails to disclose or suggest "the printer sending the portions of the print job that cannot be processed by the printer to an external rendering device" as recited in claim 8. As discussed above, in contrast to claim 8, the Cavill reference discloses processing the print data before the print data is send to the printer.

Additionally, Appellant's admitted Prior Art fails to disclose or suggest "the printer identifying portions of the print job that can be processed by the printer", as recited in claim 8. Appellant's admitted Prior Art also fails to disclose or suggest "the printer sending the portions of the print job that cannot be processed by the printer to an external rendering device", as recited in claim 8.

Further, the combination of Cavill and Appellant's admitted Prior Art fails to disclose or suggest a printer that identifies portions of the print job that can be processed by the printer, as recited in claim 8. Additionally, the combination of Cavill and Appellant's admitted Prior Art fails to disclose or suggest a printer that sends the portions of the print job that cannot be processed by the printer to an external rendering device, as recited in claim 8. Since neither reference individually discloses or suggests these features, the combination of Cavill and Appellant's admitted Prior Art is completely silent regarding these features.

Accordingly, for at least these reasons, Appellant respectfully submits that claim 8 is allowable over Cavill in view of Appellant's admitted Prior Art. Given that claims 9-12 and 14 depend from claim 8, Appellant respectfully submits that those claims are likewise allowable over Cavill and Appellant's admitted Prior Art for at least the reasons discussed above.

Claim 15 of the present application recites:

> A printer comprising:
> a communication interface; and
> a processor coupled to the communication interface, wherein the processor determines whether an entire print job can be processed by the printer, if the entire print job cannot be processed by the printer, then the printer sends the portions of the print job that cannot be processed by the printer to an external rendering device, and the printer receives rendered portions of the print job from the external rendering device.

As discussed above, the Cavill reference discloses a printer device that is not involved in the separation of print tasks into multiple portions. Instead, Cavill discloses that the separation of print tasks into multiple portions is performed by a printer driver having a server-side subsystem and a client-side subsystem. Thus, Cavill does not disclose or suggest a printer having a processor that "determines whether an entire print job can be processed by the printer" as recited in claim 15.

As discussed above, Appellant's admitted Prior Art mentions that a printer may contain its own print rendering engine to process certain types of data. However, Appellant's admitted Prior Art does not disclose or suggest a printer having a processor that "determines whether an entire print job can be processed by the printer" as recited in claim 15. Additionally, Appellant's admitted Prior Art does not disclose or suggest a printer sending portions of a print job to an external rendering device.

Further, the combination of Cavill and Appellant's admitted Prior Art fails to disclose or suggest a printer that determines whether an entire print job can be processed by the printer, as recited in claim 15. Neither Cavill nor Appellant's admitted Prior Art discuss that a printer may determine whether an entire print job can be processed by the printer. Since neither reference individually discloses or suggests such a feature, the combination of Cavill and Appellant's admitted Prior Art fails to disclose or suggest this feature.

As such, Appellant respectfully submits that claim 15 is allowable over Cavill in view of Appellant's admitted Prior Art. Given that claims 16-18 depend from claim 15, Appellant respectfully submits that those claims are likewise allowable over Cavill and Appellant's admitted Prior Art for at least the reasons discussed above.

Conclusion

The Office's basis and supporting rationale for the 103(a) rejection is not supported by the teaching of the cited references. Appellant respectfully requests that the rejections be overturned and that pending claims 1-12 and 14-18 be allowed to issue.

Respectfully Submitted,

Dated: 5-25-05

By: 

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(9) Appendix of Appealed Claims

1. A method of handling a print job, the method comprising:

determining whether the entire print job can be processed by a printer;

processing the print job, by the printer, if the entire print job can be processed by the printer;

if the entire print job cannot be processed by the printer:

sending, by the printer, the print job to an external rendering device;

receiving, by the printer, a rendered print job from the external rendering device; and

the printer printing the rendered print job received from the external rendering device.

2. A method as recited in claim 1 wherein sending the print job to an external rendering device includes sending, by the printer, a portion of the print job that cannot be processed by the printer to an external rendering device.

3. A method as recited in claim 1 wherein sending the print job to an external rendering device includes sending, by the printer, a first portion of the print job that cannot be processed by the printer to a first external rendering device and sending, by the printer, a second portion of the print job that cannot be processed by the printer to a second external rendering device.

4. A method as recited in claim 1 wherein the external rendering device is accessible via the Internet.

5. A method as recited in claim 1 wherein the external rendering device is a server coupled to the Internet.

6. A method as recited in claim 1 wherein determining whether the entire print job can be processed by the printer is performed by the printer.

7. A computer-readable memory containing a computer program that is executable by a processor to perform the method recited in claim 1.

8. A method comprising:

receiving, by a printer, a print job;

the printer identifying portions of the print job that can be processed by the printer;

the printer processing the identified portions of the print job;

the printer sending the portions of the print job that cannot be processed by the printer to an external rendering device; and

the printer receiving rendered portions of the print job from the external rendering device.

9. A method as recited in claim 8 further including the printer printing the print job by combining portions processed by the printer and rendered portions received from the external rendering device.

10. A method as recited in claim 8 wherein sending the portions of the print job that cannot be processed by the printer to an external rendering device includes the printer sending a first portion of the print job that cannot be processed by the printer to a first external rendering device and the printer sending a second portion of the print job that cannot be processed by the printer to a second external rendering device.

11. A method as recited in claim 8 wherein the external rendering device is accessible via the Internet.

12. A method as recited in claim 8 wherein the external rendering device is a server coupled to the Internet.

14. A computer-readable memory containing a computer program that is executable by a processor to perform the method recited in claim 8.

15. A printer comprising:

a communication interface; and

a processor coupled to the communication interface, wherein the processor determines whether an entire print job can be processed by the printer, if the entire print job cannot be processed by the printer, then the printer sends the portions of the print job that cannot be processed by the printer to an external rendering device, and the printer receives rendered portions of the print job from the external rendering device.

16. A printer as recited in claim 15 wherein the communication interface is a network communication interface coupled to the Internet.

17. A printer as recited in claim 15 wherein the external rendering device is a server coupled to the communication interface.

18. A printer as recited in claim 15 wherein the printer sends a first portion of the print job that cannot be processed by the printer to a first external rendering device and the printer sends a second portion of the print job that cannot be processed by the printer to a second external rendering device.